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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,121	07/13/2001	Mathieu Joanicot	RN95059D2	9393

7590

09/01/2004

RHODIA INC.
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259 Prospect Plains Road
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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,121

Applicant(s)

JOANICOT ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/28/04 & 06/23/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45,46,48-50,61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45,46,48-50,61 and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 05/28/04 coupled with Counsel's persuasive arguments is sufficient to remove the rejection of the claims(45, 46, 48-50, 61 and 62) under 35 U.S.C. 103(a) over Uemae et al(U.S. 5,404,879), 12/02/03, paragraph # 9, and the rejection of claims(45,46, 48-50, 61 and 62) under 35 USC § 112, second paragraph, 12/02/03, paragraph # 5.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in FRANCE on 04/28/1995. It is noted, however, that applicant has not filed a certified copy of the 95 05123 application as required by 35 U.S.C. 119(b).

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the limitations of claims 48 and 49, as far as the Examiner can tell, has not been established. Reference page 6 @ lines 21 and 22 wherein it is recited that the ratio, (equivalent), of the masked isocyanate to the alcohol functional groups (NCO/OH) is between 0.1 and 10, preferably between 0.2 and 4.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 45, 46, 48-50, 61 and 62 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takeuchi et al (U.S. 5,453,458).

Takeuchi et al disclose and exemplify compositions, useful as protective coatings for automobile surfaces, defined basically as containing a core/shell polymer latex, governed by a weight-averaged particle size of 0.1 to 50 micrometers, wherein the shell is built up from 25-95 wt.% of an aromatic vinyl monomer, 5-40 wt.% of alpha, beta-ethylenically unsaturated carboxylic acids and/or hydroxyalkyl esters of alpha, beta-ethylenically unsaturated carboxylic acid and 0-70 wt.% of other comonomer(s), a crosslinking agent which includes an isocyanate compound, a plasticizer and other conventional adjuvants such as pigments, etc. Takeuchi et al specifically teach a core-shell polymer which comprises (a) a core layer polymerized from a core forming monomer mainly comprising an aromatic monovinyl monomer; and (b) a shell layer polymerized from a shell forming monomer which comprises: (b1) 25-95% by weight of an aromatic monovinyl monomer as a first monomer; (b2) 5-40% by weight of at least one monomer selected from the group consisting of an alpha, beta-ethylenically unsaturated carboxylic acid and a hydroxyalkyl ester of alpha, beta-ethylenically unsaturated carboxylic acid as a second monomer; and (b3) 0-70% by weight of a third monomer which is other than the first and second monomers and is copolymerizable therewith, wherein the shell layer is contained in an amount of 5-70% by weight based on the core-shell polymer, and the core-shell polymer having a weight average particle size of 0.1-50 micrometers. Takeuchi et al further specifically teach a plastisol which comprises the core-shell polymer dispersed in a liquid plasticizer. Takeuchi et al further specifically teach that the plastisol may contain a crosslinking agent which includes an organic

compound which has at least two functional groups in the molecule reactive to carboxyl and/or hydroxyl groups of the core-shell polymer wherein, the functional groups include isocyanate and blocked isocyanate groups. See, e.g., the Abstract, cols. 4-9 and the Runs, especially Run 6 and especially col. 4, lines 21-40, col. 5, lines 15-54 and col. 8, lines 35-57 of Takeuchi et al. Takeuchi et al therefore anticipate the instantly claimed invention.

As to the pH, acidic and hydroxyl functional groups distance and other remaining properties, it is reasonably presumed that these properties would be met by Takeuchi et al since the composition of Takeuchi et al is essentially the same as and made under essentially the same conditions as the claimed composition. The onus is shifted to applicant to show that, in fact, this is not the case.

It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. In re Best, 195 USPQ 430, 433 (CCPA 1977); In re Fitzgerald et al., 205 USPQ 594, 596 (CCPA 1980).

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290.

Even if it turns out that the claims are not anticipated then, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Takeuchi et al, the instantly claimed

composition having a population A of latex particles and a population B of particles bearing isocyanate functional group(s) and with a reasonable expectation of success.

As to the dependent claims, the limitations are either taught by Takeuchi et al, suggested by Takeuchi et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Response to Arguments

7. Applicant's arguments filed 05/28/04 have been fully considered but they are not persuasive.

Relative to Takeuchi et al---The crux of Counsel's arguments appear to hinge on the silence with respect to the location of the acidic and hydroxyl functional groups and the pH of between 4 and 9 and, to this end, it is urged and maintained that since the composition of Takeuchi et al is essentially the same as and made under essentially the same conditions as the claimed composition and in the absence of the USPTO to have at its disposal the tools nor facilities deemed necessary to make physical determinations of this sort, these properties would be expected to be possessed by the composition of Takeuchi et al. There is absolutely nothing ironclad on this record diffusing this issue.

Mere Counsel's arguments unsupported by factual evidence are given little weight (In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972)).

Conclusion

8. The prior art to Uhl et al(U.S. 4,849,262) listed on the attached FORM PTO 892 is cited as of interest in teaching pigment printing pastes comprising finely divided polyisocyanate dispersions and, as binders, self-crosslinking aqueous plastics dispersions and aqueous dispersions of binders which contain functional groups such as hydroxyl and carboxyl functional groups which react with isocyanates. A rejection, in the future, based on Uhl et al may be made. However, since the outstanding rejection still appears to be valid, a rejection at this time is not being made.

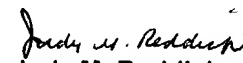
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
08.27.04